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Paper No. 16

In re Application of
Melvin Hatch
Application No. 09/941,029
Filed: August 28, 2001
Attorney Docket No. NM Tech 8

:
: DECISION ON
: RENEWED PETITION
:

This is a decision on the renewed petition filed on January 16, 2004 by which petitioner again requests supervisory review of the examiner's refusal to enter the proposed drawing correction filed on April 15, 2003 as containing prohibited new matter. The renewed petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The renewed petition is dismissed.

In the original petition filed on October 31, 2003, petitioner alleged that the proposed drawing correction filed on April 15, 2003, a copy of which was attached to the petition, is fully supported by the original application disclosure, in particular the disclosure found in the specification of the application at the top of page 5. Petitioner, therefore, requested entry of the proposed drawing correction.

The original petition was dismissed on the basis of the following analysis of the application disclosure as originally filed:

A review of this application shows that as originally filed, this application discloses two specific embodiments of a metallic heat conducting support for a round or curved bottom vessel such as a flask, especially a glass flask (specification, pages 4-8). The structure of the support is that an inner portion 21 concavely curved at bottom 22 to compliment the curved lower surface of a curved or round bottom vessel is joined to an outer portion 24. The outer portion extends downwardly from the joint between the inner and outer portions so that the outer portion "surrounds" the inner portion. The outer portion extends towards a supporting base, designated by the reference numeral 26. The base could be formed unitarily with the outer portion (specification, page 4 lines 22-23) or could be formed out of a separate piece of material (specification, page 5, lines 1-3). The base 26 is described as being substantially flat or as having a flat portion, and if formed from a separate piece of material, the base may be continuous or it may have apertures therein, (specification, page 5, lines 6-8). The base is described as having any desired shape, and the two disclosed embodiments differ in that in the Figure 1-2 embodiment, the base is "essentially square" with rounded corners, while in the Figure 3-4 embodiment, the base is circular (specification page 5, lines 8-14). In both embodiments that are specifically disclosed, base 26 is described as being a brim 27 that extends radially outwardly from where the outer portion 24 joins base 26 and provides rigidity and support for base 26. However, the brim 27 is disclosed as "not necessary", and may be eliminated altogether, (specification, page 6 lines 3-15), resulting in base 26 being the lowermost edge of outer portion 24. Brim 27, if used, may be extended as far as necessary, (specification, page 6 lines 3-15).

As noted in the Decision treating the original petition, the examiner first objected to the drawings as originally filed in the examiner's first Office action. The drawings were objected to as failing to illustrate a base having apertures and as failing to illustrate a separately formed base attached to the outer portion (paper No. 3, page 2, first two paragraphs). The basis for the objection was 37 CFR 1.83 which requires, *inter alia*, that the drawing in a nonprovisional application show every feature of the invention specified in the claims. Original claim 8 calls for a base that has apertures, while original claim 10 recites the base as being an element that is separate from, and attached to, an outer portion of the support. In response to the examiner's objection, petitioner filed a proposed drawing correction (part of paper No. 4). However, the examiner refused entry, holding that the correction as proposed contained new matter (paper No. 5, page 2, paragraph 1). The examiner again objected to the drawings under 37 CFR 1.83 and required

corrected drawings (paper No. 5, page 2, paragraphs 2-3).

In response to paper No. 5, petitioners submitted the proposed drawing corrections as part of paper No. 6. The examiner held those proposed corrections, which differ from the corrections proposed as part of paper No. 4, to be prohibited new matter, and declined to enter them.

After considering the record and the arguments presented in the original petition, it was held that the proposed drawings as submitted with paper No. 6 to contain new matter because the illustrated base 26 as comprising a sheet of material that **extends radially inwardly of outer portion 24, and completely beneath inner portion 21 and rounded bottom 22 of the support.**

The arguments presented in the renewed petition do not address the basis that supported the holding in the Decision that dismissed the original petition. Petitioner is arguing that the base 26, by original disclosure, could be a separate element rather than an element integrally formed with outer portion 24. And in this, petitioner is correct in that page 5, lines 1-3 of the original specification so states. However, as noted in the Decision dated November 14, 2003, nothing in original Figures 1-4 shows base 26, or any element other than members 21 and 22 (which are not the base in question), extending radially inwardly of the outer portion 24, let alone beneath inner portion 21 and rounded bottom 22, in the manner illustrated by proposed Figure 1a filed as part of paper No. 6. Indeed, the specification describes base 26 as being the sole necessary "base" (specification, page 6, lines 3-15), or as including brim 27 which extends radially outwardly of the outer portion 24. However, proposed Figure 1a shows what can only be taken as a sheet of material extending completely beneath the support, because the proposed figure is a sectional view, and the element labeled 26 extends beneath the inner portion 21, rounded bottom 22 and outer support member 24 radially inwardly of these elements. That brim 27 is described as being "essentially square" or, in a second embodiment, as being "circular", does not imply that the brim 27 (or any other element that might comprise base 26) extends radially inwardly of elements 21, 22 and 24. Clearly, such an interpretation is not the only necessary and reasonable interpretation of petitioner's disclosure. It is equally reasonable, from petitioner's explicit disclosure as a whole, to conclude that base disclosed by petitioner is a radially outwardly extending "brim" that extends outside of outer portion 24 for any desired length, as in United States Patent 4,726,553 (cited in the present record) which shows a member 32 that is not a complete sheet that extends beneath the supported receptacle but is merely a radially outwardly extending flange, notwithstanding the description in USP 4,726,553 of member 52 as being "square." Alternatively, it is clear that petitioner's base 26 may simply consist of the bottom edge of outer portion 24 in a manner similar to the lowermost portion of element 1 of United States Patent 1,651,346 (cited in the present record). But there is absolutely no reason for one of ordinary skill in the art reading petitioner's disclosure to conclude that the base originally disclosed by petitioner is of the form illustrated in proposed Figure 1a that was filed as part of paper No. 6, wherein element 27 extends beneath members 21 and 22 completely across petitioner's support.

While careful consideration has been given to the arguments presented in the renewed petition, those arguments are simply not persuasive, for the reasons that are, again, presented above.

This application is being returned to storage awaiting the filing of a reply brief, if any. The application will ultimately be forwarded to the Board of Patent Appeals and Interferences in due course.

PETITION DISMISSED.



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